UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 08/878,908 | 06/19/1997 | KARL-LUTZ LAUTERJUNG | 09114/005001 | 8837 |

21906 7590 03/03/2006

TROP PRUNER & HU, PC
8554 KATY FREEWAY
SUITE 100
HOUSTON, TX 77024

| EXAMINER | |
|---|---|
| PREBILIC, PAUL B | |
| **ART UNIT** | **PAPER NUMBER** |
| 3738 | |

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

c

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 08/878,908 | LAUTERJUNG, KARL-LUTZ | |
| | Examiner | Art Unit | |
| | Paul B. Prebilic | 3738 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *19 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *32,65-73,75-79,81 and 82* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32,65-73,75-79,81 and 82* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/26/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 82 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a strand of wire having different radii based upon the longitudinal axis of the ring, does not reasonably provide enablement for a strand that has different radii (i.e. wire thicknesses) along the length of the single strand. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Upon review of the specification on page 7, lines 5-19 and lines 27-30, the Examiner concluded that there is no enabling disclosure for making a strand of wire that has various thicknesses, and thus, different radii along the length of that strand. Rather, only the structure of different strands with different diameters appears to be enabled. For this reason, the Examiner concluded that the presently claimed subject matter is not fully enabled.

### *Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The subject matter of present claim 82 setting forth "at least two of said overlapping windings having different radii" does not have clear antecedent basis from

the specification. For this reason, if Applicant is able to show that this subject matter is fully enabled, he would then be required to give this language antecedent basis for the claimed subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 65-73, 75-79, and 81-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Das (US 5,554,181) as evidenced by Solomon et al (US 4,948,860) or Scholander et al (US 5,840,190), or alternatively under 35 U.S.C. 103(a) as obvious over Das (US 5,554,181) alone. Das discloses a wire stent that is formed by winding wire around a mandrel; see the figures. The ring or element as claimed is met by the stent (101) of Das and the catheter as claimed is the graft of Das; see Figures 9 and 10. The catheter is a graft to the extent that this term can be given patentable weight because grafts can have all the properties of catheters being made of the same material in the same way; see Solomon on column 3, line 52 to column 4, line 3 and see Scholander on column 4, lines 20-32. For these reason, the Examiner asserts that the claim language is fully met but the structure shown in Figure 9 of Das.

Alternatively, if one interprets the claim language as not being met because one does not believe a catheter is a graft, the Examiner asserts that the claim language is rendered obvious over Das alone because Das discloses that the stent thereof can be used as a skeleton for a vascular graft; see column 10, lines 60-63. Therefore, it is the Examiner's position that it would have been obvious to use the stent (101) of Das near at least one end of the graft so that the edge of the graft is prevented from detaching from the blood vessel, thus possibly blocking blood flow.

With regard to claim 82, the different radii of the overlapping windings are met by the radii at axially displaced portions of the windings.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marcade (US 5,676,696) in view of Palmaz et al (US 5,316,023) and Das (US 5,554,181). Marcade meets all the limitations of the claim except for the use of a plurality of resilient elements or stents in the third and forth sections with radially overlapping windings in the second section; see the front page, Figure 2, and column 13, line 44 to column 14, line 4. However, Palmaz teaches that it was known to use a plurality of stents instead of one where a long section of a graft needs support; see Figures 9, 10A, and 10B as well as column 10, line 1 to column 11, line 20. Das teaches that it was known to make stents with radially overlapping windings as skeletons for vascular grafts. Therefore, it is the Examiner's position that it would have been obvious to use a plurality of stents, with at least one made with overlapping windings, as taught by Palmaz and Das, in the Marcade invention for the same reasons that Palmaz and Das do the same and in order

to use widely available less costly stents as apposed to one customized for each graft of Marcade.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Prebilic
Primary Examiner
Art Unit 3738